

### REMARKS

Upon entry of this Amendment, claims 2-20 and 34-47 will be pending in this application, claims 1 and 21-33 having been cancelled without prejudice to their reintroduction in this application or a future continuation or divisional patent application.

Applicant acknowledges the Examiner's indication that claims 12-20 are allowed and claims 8 and 9 contain allowable subject matter. In accordance with the Examiner's constructive suggestion, claims 8 and 9 have been amended to include the features of its independent claim, i.e., claim 1. Claim 10 has also been amended to include the features of independent claim 1. The dependencies of claims 2 and 5-7 have been amended to account for the cancellation of claim 1.

Applicant respectfully submits that the subject matter of new claims 34-47 is supported by the original disclosure. In particular, claims 34 and 36-47 correspond to claims 1, 12-14, 2-5, and 7-11, respectively. Claim 35 is supported in the original disclosure, for example, at page 12, line 1 to page 13, line 16.

Accordingly, Applicant respectfully requests approval and entry of the claim amendments and new claims.

The amendments to the specification are supported in the original disclosure at, for example, page 30, lines 15-18 (corresponding to original claims 10 and 11). The claims constitute part of the original disclosure. Accordingly, Applicant respectfully requests approval and entry of the amendments to the specification.

### **RULE 133 STATEMENT**

Applicant acknowledges with appreciation the assistance of Examiner Pryor during the telephone interview of December 17, 2003, which was conducted after a personal interview scheduled for the preceding day was postponed. During the interview, various claim amendments and arguments were discussed and agreed upon.

In particular, an agreement was reached to allow claim 10, once rewritten into independent format, for the reasons expressed below. An agreement was also reached to permit the addition of new method claims to the application, with the method claims mirroring features contained in claim 1.

### **CLAIM REJECTIONS -- 35 U.S.C. § 102**

Claims 27-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,316,917 to Antoshkiw et al. (hereinafter "Antoshkiw").

This rejection has been rendered moot by the cancellation of claims 27-30. Accordingly, withdrawal of this rejection is respectfully requested.

### **CLAIM REJECTIONS -- 35 U.S.C. § 103**

Claims 1-7, 10, 11, 21-26, and 31-33 stand rejected under 35 U.S.C. § 103(a) (hereinafter "Section 103(a)") as being unpatentable over U.S. Patent No. 5,059,437

to Todd, Jr. (hereinafter "Todd") and JP 56089832 (hereinafter "JP '832") in view of Antoshkiw.

The rejection of claims 1, 21-26, and 31-33 has been rendered moot by the cancellation of those claims. Claims 2-7 depend from claim 8, which the Examiner has identified as containing allowable subject matter. The rejection of claims 10 and 11 is respectfully traversed.

According to claim 10 (and claim 11 which depends therefrom), the incapacitating formulation comprises a solvent system comprising a mixture of propylene glycol esters of short chain fatty acids and glycerol tris (2-ethylhexanoate) and an incapacitating agent present in an amount of about 0.18% to about 3% by weight of the solvent system.

The Examiner has relied on Todd for its disclosure of oleoresin of paprika as an incapacitating agent. Applicant respectfully submits that Todd, when taken alone or in combination with JP '832 and Antoshkiw, fails to disclose or reasonably suggest, among other things, an incapacitating agent present in an amount of about 0.18 weight percent to about 3 weight percent of the solvent system. Todd is directed to a paprika pigment composition and, as such, discloses compositions containing paprika as the majority component. Attention is directed to column 3, lines 37-43, which disclose that the ratio of nonionic surface-active agent (A) to paprika (B) is between 0.1:1 and 1.2:1. Other examples from Todd discuss compositions having 50 weight percent paprika.

The Examiner stated in the March 26, 2003 Office Action that "with respect to the amounts and ratios of ingredients, one having ordinary skill in the art would have been expected to determine the optimum amounts and ratios through routine experimentation." In response, Applicant respectfully submits that the "optimum" amount of paprika for the pigment compositions disclosed in Todd would not have necessarily been the same as the "optimum amount" of incapacitating agent in non-

lethal incapacitating composition. Further, Todd is devoid of any motivation of using its composition as an incapacitating composition or adjusting the concentration of paprika in the composition to optimize its capabilities as an incapacitating composition.

For this reason, Applicant respectfully submits that the Section 103(a) rejection of claim 10, and claim 11 which depends therefrom, should be withdrawn.

### Conclusion

In view of the foregoing, Applicant respectfully submits that the pending claims are allowable and that the application is in condition for allowance.


Reconsideration of the application in view of this Response and its passage to issue are respectfully requested.

If, after reviewing the above, the Examiner believes any issues remain unresolved, the favor of an Examiner interview is requested and the Examiner is requested to contact the undersigned, by telephone, to schedule the same.

This Response is being filed within three months of the date of the Office Action. Accordingly, a petition for extension of time and a petition fee are not being concurrently filed. If any fees are due in connection with the filing of this Response, please charge Deposit Account No. 50-0548 and accept this paper as a petition for extension.

Respectfully submitted,

LINIAK, BERENATO & WHITE

By:   
Thomas P. Liniak  
Registration No. 33,415  
Tel. No. (301) 896 0600  
Fax. No. (301) 896-0607

December 22, 2003